

REMARKS

This paper is presented in response to the Office Action. Claims 1, 4, 7, 12, 19, 22, 23, and 29-32 are amended herein. Claims 26 and 33-36 were canceled in a previous paper. Claims 1-25, 27-32, and 37-42 are pending in the application.

Reconsideration of the application is respectfully requested in view of the aforementioned amendments to the claims and the following remarks. For the convenience and reference of the Examiner, Applicants' remarks are presented in the order in which the corresponding issues were raised in the Office Action.

I. General Considerations

Applicants respectfully note that the remarks herein do not constitute, nor are they intended to be, an exhaustive enumeration of the patentable distinctions between any cited references and the invention, example embodiments of which are set forth in the claims of this application. Rather, and in consideration of the fact that various factors make it impractical to enumerate all the patentable distinctions between the invention and the cited art, as well as the fact that the Applicants have broad discretion in terms of the identification and consideration of the base(s) upon which the claims distinguish over the cited references, the distinctions identified and discussed herein are presented solely by way of example. Consistent with the foregoing, the discussion herein is not intended, and should not be construed, to prejudice or foreclose contemporaneous or future consideration by the Applicants, in this case or any other, of: additional or alternative distinctions between the invention and the cited references; and/or, the merits of additional or alternative arguments.

Applicants note as well that the remarks, or a lack of remarks, set forth herein are not intended to constitute, and should not be construed as, an acquiescence, on the part of the Applicants: as to the purported teachings or prior art status of the cited references; as to the characterization of the cited references advanced by the Examiner; or as to any other assertions, allegations or characterizations made by the Examiner at any time in this case. Applicants reserve the right to challenge the purported teachings and purported prior art status of the cited references at any appropriate time.

With particular reference to the claim amendments, Applicants note that while claims 1, 4, 7, 12, 19, 22, 23, and 29-32 have been amended herein, such amendments have been made in the interest of expediting the allowance of this case. Notwithstanding, Applicants, may, on further consideration, determine that claims of broader scope than those now presented are supported. Accordingly, Applicants hereby reserve the right to file one or more continuing applications with claims broader in scope than the claims now presented.

Consistent with the points set forth above, Applicants submit that neither the claim amendments set forth herein, nor any other claim amendments, claim cancellations or statements advanced by the Applicants in this or any related case, constitute or should be construed as, an implicit or explicit surrender or disclaimer of claim scope with respect to the cited, or any other, references.

II. Objection to Claim 32

The Examiner has objected to claim 32 because of an informality. In light of the amendment to claim 32 herein, Applicants respectfully submit that the objection to claim 32 has been overcome and should be withdrawn.

III. Claim Rejections under 35 U.S.C. § 103(a)

Applicants respectfully note at the outset that in order to establish a *prima facie* case of obviousness, it is the burden of the Examiner to demonstrate that three criteria are met: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Manual of Patent Examining Procedure* ("MPEP") § 2143.

The Examiner has rejected claims 1, 11, 23, 24, 29, 37, 38, 41, and 42 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,557,437 to Sakai et al. ("*Sakai*") in view of U.S. Patent No. 5,920,414 to Miyachi et al. ("*Miyachi*"). The Examiner has also rejected claims 2-7 and 25 under 35 U.S.C. § 103(a) as being unpatentable over *Sakai* in view of *Miyachi* and further in view of U.S. Patent Application Publication No. 2002/0021468 to Kato et al. ("*Kato*"). The Examiner has further rejected claims 12-14 and 31 under 35 U.S.C. § 103(a) as being unpatentable over *Sakai* in view of U.S. Patent No. 5,557,437 to Platt ("*Platt*"). The Examiner has further rejected claims 15-19, 39, and 40 under 35 U.S.C. § 103(a) as being unpatentable over *Sakai* in view of *Platt* and further in view of *Kato*. Applicants respectfully disagree and submit that for at least the reasons set forth below, the rejections should be withdrawn.

A. Claims 1-7, 11, 23-25, 29, 37, 38, 41, and 42

As amended herein, independent claim 1 requires:

A transceiver...comprising:
an input port that receives electrical signals from a host, the input port being in communication with an optical transmitter for generating an optical signal for transmission to the optical network;
...
a pass-through port operable to send the incoming electrical signal to a device external to the transceiver; and
a pass-through path configured to bypass the optical transmitter in selectively coupling the incoming electrical signal from the input port to the pass-through port.

(*Emphasis added*). As amended herein, independent claim 23 requires:

A transceiver...comprising:
an input port for receiving an electrical input signal from a host;
an optical transmitter generating an optical output in response to the electrical input signal applied to a transmitter input;
an optical receiver generating an electrical output signal at a receiver output in response to an optical input;
an output port for relaying the electrical output signal to the host;
...
a pass-through port for sending electrical signals to a device external to the transceiver; and
at least one of:
a first pass-through path configured to bypass the optical transmitter in selectively coupling the electrical input signal from the input port to the pass-through port in a pass-through mode; and
a second pass-through path configured to selectively couple the electrical output signal from the optical receiver to the pass-through port in a pass-through mode.

(*Emphasis added*). As amended herein, independent claim 29 requires:

A transceiver, comprising:
an optical transmitter capable of generating an optical output in response to an electrical input signal applied to a transmitter input;
...
a transceiver input port for receiving an electrical input signal;
...
a pass-through port operable to send the electrical input signal to a device external to the transceiver; and
a pass-through path configured to bypass the optical transmitter in selectively coupling the electrical input signal from the input port to the pass-through port in a pass-through mode.

(*Emphasis added*). Support for these amendments can be found, for example, in paragraphs [0011], [0016], [0032], and [0061]-[0063] and Figure 6 of the specification.

In the rejection of claims 1, 23, and 29, the Examiner has admitted that "Sakai differs from claim 1, 23...and 29 in that he fails to teach a pass-through port and a pass-through path configured to selectively couple an incoming electrical signal from the input port to the pass-through port." *Office*

Action, page 3. However, the Examiner has asserted that “Miyachi et al teaches a pass-through port and a pass-through path configured to selectively couple an incoming electrical signal from the input port to the pass-through port.” *Office Action, page 3.* In support for these assertions, the Examiner has made only general references to Figure 13 and column 16, line 63-67 and column 17, lines 1-35 of *Miyachi*.

As is evident from the generalized references to *Miyachi* set forth in the Office Action, the Examiner has failed to specifically identify any correspondence between elements purportedly disclosed in *Miyachi* and “a pass-through port...” and “a [] pass-through path...” recited in rejected claims 1, 12, and 29. Moreover, the cited passage does not appear to make any reference to a “pass-through port” or a “pass-through path.” Instead, the cited passage of *Miyachi* teaches that each of the “data signals S_1, S_2, \dots, S_N are inputted to optical modulators $12_1, 12_2, \dots, 12_N$ ” or to an optical modulator 12_{N+1} in Figure 13 and “the outputs of [semiconductor lasers $10_1, 10_2, \dots, 10_N$ or 10_{N+1}] are subjected to intensity modulation at the optical modulators $12_1, 12_2, \dots, 12_N$ [or 12_{N+1}] and the modulated outputs are multiplexed at an optical wavelength multiplexer 13.” *See column 16, line 63 – column 17, line 14.*

Applicants thus respectfully submit that for at least the foregoing reasons, the rejection of claims 1, 23, and 29, and claims 2-7, 11, 24, 25, 37, 38, 41, and 42 which depend therefrom, should be withdrawn.

B. Claims 12-19, 31, 39, and 40

As amended herein, independent claim 12 requires:

A transceiver...comprising:
an optical transmitter generating an optical output in response to an electrical input signal applied to an input of the optical transmitter;
...
a pass-through port operable to send the electrical output signal to a device external to the transceiver; and
a pass-through path configured to selectively couple the electrical output signal from the optical receiver to the pass-through port.

(*Emphasis added*). As amended herein, independent claim 31 requires:

A transceiver, comprising:
...
an optical receiver generating an electrical output signal at a receiver output in response to an optical input;
...
a pass-through port for sending electrical signals to a device external to the transceiver; and
a pass-through path for selectively coupling the electrical output signal from the optical receiver to the pass-through port in a pass-through mode.

(*Emphasis added*). Support for these amendments can be found, for example, in paragraphs [0011], [0016], [0032], and [0061]-[0063] and Figure 6 of the specification.

In the rejection of claims 12 and 31, the Examiner has admitted that “Sakai et al differs from claim 12 and 31 in that he fails to teach a pass-through port and a pass-through path configured to selectively couple the electrical output signal from the optical receiver to the pass-through port.” *Office Action, page 5*. However, the Examiner has asserted that “Platt teaches a transceiver comprises a transmitter 106b and a receiver 106a (Fig. 1B). Platt further teaches a pass-through port (i.e., input terminals of the BIST, Fig. 1B) and a pass-through path (i.e., a bus 140, Fig. 1B) configured to selectively couple the electrical output signal from the receiver 106a to the pass-through port (i.e., col. 3, lines 35-67, col. 4, lines 1-67 and col. 5, lines 1-10).” *Office Action, page 5*.

Figure 1B is labeled by *Platt* as a “system block diagram of a UNI 102 which contains a BIST FSB 120.” *Column 4, lines 45-46*. It thus appears that the Examiner has characterized the “input terminal of the BIST” of Figure 1B of *Platt* as purportedly corresponding to the “pass-through port” as recited in claims 12 and 31. *Office Action, page 5*. Despite the Examiner’s assertions and characterizations however, the Examiner has not established that the “BIST FSB 120” of Figure 1B is configured to send “electrical signals [generated by the optical receiver] to a device external to the transceiver...” as required by amended claims 12 and 31.

Applicants thus respectfully submit that for at least the foregoing reasons, the rejection of claims 12 and 31, and claims 13-19, 39, and 40 which depend from claim 12, should be withdrawn.

IV. Allowable Subject Matter

Applicants acknowledge with thanks the indication of the Examiner that claims 8-10, 20-22, 27, 28, 30 and 32 would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. In light of the remarks herein and the amendments made herein to each of the base claims from which these claims depend, however, Applicants respectfully decline to rewrite these claims at this time.

CONCLUSION

In view of the remarks submitted herein, Applicants respectfully submit that each of the claims 1-25, 27-32, and 37-42 pending in this application is in condition for allowance. Therefore, reconsideration of the rejections is requested and allowance of those claims is respectfully solicited. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate the same with the undersigned attorney.

Dated this 9th day of January 2008.

Respectfully submitted,

/Peter F. Malen Jr./ Registration No. 45,576

Peter F. Malen Jr.
Attorney for Applicants
Registration No. 45,576
Customer No. 022913
Telephone: (801) 533-9800